



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,292	12/10/2001	Laurence E. Holt	1044.012US1	8482

23441 7590 08/26/2004

LAW OFFICES OF MICHAEL DRYJA
704 228TH AVENUE NE
PMB 694
SAMMAMISH, WA 98074

EXAMINER

YOUNG, JOHN L

ART UNIT PAPER NUMBER

3622

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/683,292

Applicant(s)

HOLT, LAURENCE E.

Examiner

John L Young

Art Unit

3622

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 11-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/28/02 & 4/31/02.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

NON-FINAL REJECTION

DRAWINGS

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §101

2. **Rejections Withdrawn.**

CLAIM REJECTION — 35 U.S.C. §103(a)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 11-20 are rejected under 35 U.S.C. §103(a) as being obvious over Ferguson US 5,819,092; class 717/113 [cross ref. class 705/39] (Oct. 06, 1998) (herein referred to as ("Ferguson").

As per independent claim 11, Ferguson (FIG. 18; FIG. 19; col. 10, ll. 1-10; col. 11, ll. 9-26; and col. 28, ll. 53-67) shows “registering by a plurality of users with an information provider over a computer network, where personal information regarding the plurality of users is stored by the information provider. . . .”

Ferguson (col. 29, ll. 65-67; col. 30, ll. 1-58; col. 14, ll. 30-67; the ABSTRACT; col. 1, ll. 15-67; col. 2, ll. 1-67; col. 3, ll. 40-55; col. 4, ll. 51-67; col. 9, ll. 30-67; col. 10, ll. 1-10; col. 11, ll. 9-26; col. 12, ll. 33-67; col. 23, ll. 30-67; col. 24, ll. 60-67; col. 27, ll. 1-67; col. 28, ll. 53-67; col. 30, ll. 59-65; col. 31, ll. 30-45; col. 34, ll. 10-17; FIG. 7; FIG. 14; FIG. 18; FIG. 19; FIG. 23; and FIG. 24; and whole document) implicitly shows all of the elements and limitations of claim 1.

Ferguson lacks an explicit recitation of “paying by the information provider to each of the sub-plurality of the plurality of users a portion of an amount collected by the information provider from the organization for access to the desired sub-set of the personal information regarding the user.”

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Ferguson (col. 29, ll. 65-67; col. 30, ll. 1-58; col. 14, ll. 30-67; the ABSTRACT; col. 1, ll. 15-67; col. 2, ll. 1-67; col. 3, ll. 40-55; col. 4, ll. 51-67; col. 9, ll. 30-67; col. 10, ll. 1-10; col. 11, ll. 9-26; col. 12, ll. 33-67; col. 23, ll. 30-67; col. 24, ll. 60-67; col. 27, ll. 1-67; col. 28, ll. 53-67; col. 30, ll. 59-65; col. 31, ll. 30-45; col. 34, ll. 10-17; FIG. 7; FIG. 14; FIG. 18; FIG. 19; FIG. 23; and FIG. 24; and whole document) implicitly shows “paying by the information provider to each of the sub-plurality of the plurality of users a portion of an amount collected by the information

provider from the organization for access to the desired sub-set of the personal information regarding the user. . . .”; and it would have been obvious to modify and interpret the disclosure of Ferguson cited above as showing “paying by the information provider to each of the sub-plurality of the plurality of users a portion of an amount collected by the information provider from the organization for access to the desired sub-set of the personal information regarding the user. . . .”, because modification and interpretation of the cited disclosure of Ferguson would have provided means where “*a user may be paid for certain actions. . . .*” (see Ferguson (col. 4, ll. 62-67)) based on the motivation to modify Ferguson so as “*a user may be paid when that user fills out a marketing questionnaire. . . .*” (see Ferguson (col. 4, ll. 60-67)); and

Ferguson lacks an explicit recitation of “requesting a desired second sub –set of the personal information of the user by a second organization to the information provider based on the user identifier as retrieved from the user. . . .”

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Ferguson (col. 14, ll. 20-67; col. 29, ll. 65-67; col. 30, ll. 1-58; col. 14, ll. 30-67; the ABSTRACT; col. 1, ll. 15-67; col. 2, ll. 1-67; col. 3, ll. 40-55; col. 4, ll. 51-67; col. 9, ll. 30-67; col. 10, ll. 1-10; col. 11, ll. 9-26; col. 12, ll. 33-67; col. 23, ll. 30-67; col. 24, ll. 60-67; col. 27, ll. 1-67; col. 28, ll. 53-67; col. 30, ll. 59-65; col. 31, ll. 30-45; col. 34, ll. 10-17; FIG. 7; FIG. 14; FIG. 18; FIG. 19; FIG. 23; and FIG. 24; and whole document) implicitly shows “requesting a desired second sub –set of the personal information of the user by a second organization to the information provider based on the user identifier as retrieved from the user. . . .”; and it would have

been obvious to modify and interpret the disclosure of Ferguson cited above as showing “requesting a desired second sub –set of the personal information of the user by a second organization to the information provider based on the user identifier as retrieved from the user. . . .”, because modification and interpretation of the cited disclosure of Ferguson would have provided means where “*a user may be paid for certain actions. . . .*” (see Ferguson (col. 4, ll. 62-67)) based on the motivation to modify Ferguson so as “*a user may be paid when that user fills out a marketing questionnaire. . . .*” (see Ferguson (col. 4, ll. 60-67))

As per claim 12, Ferguson shows the method of claim 11. (See the rejection of claim 11 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 12.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 12 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 12 because such combination would have provided means where “*a user may be paid for certain actions.*” (See Ferguson (col. 4, ll. 62-67)).

As per claim 13, Ferguson shows the method of claim 11. (See the rejection of claim 11 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 13.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 13 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 13 because such combination would have provided means where *"a user may be paid for certain actions."* (See Ferguson (col. 4, ll. 62-67)).

As per claim 14, Ferguson shows the method of claim 11. (See the rejection of claim 11 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 14.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 14 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 14 because such combination would have provided means where *"a user may be paid for certain actions."* (See Ferguson (col. 4, ll. 62-67)).

As per claim 15, Ferguson shows the method of claim 11. (See the rejection of claim 11 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 15.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 15 were notoriously well known and expected in the art at the

time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 15 because such combination would have provided means where *"a user may be paid for certain actions."* (See Ferguson (col. 4, ll. 62-67)).

Independent claim 16 is rejected for substantially the same reasons as independent claim 11.

As per claim 17, Ferguson shows the method of claim 16. (See the rejection of claim 16 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 17.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 17 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 17 because such combination would have provided means where *"a user may be paid for certain actions."* (See Ferguson (col. 4, ll. 62-67)).

As per claim 18, Ferguson shows the method of claim 17. (See the rejection of claim 17 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 18.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 18 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 18 because such combination would have provided means where *"a user may be paid for certain actions."* (See Ferguson (col. 4, ll. 62-67)).

As per claim 19, Ferguson shows the method of claim 17. (See the rejection of claim 17 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 19.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 19 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 19 because such combination would have provided means where *"a user may be paid for certain actions."* (See Ferguson (col. 4, ll. 62-67)).

As per claim 20, Ferguson shows the method of claim 17. (See the rejection of claim 17 supra).

Ferguson lacks an explicit recitation of the elements and limitations of claim 20.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claim 20 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at

the time of the invention to include the elements and limitations of claim 20 because such combination would have provided means where *"a user may be paid for certain actions."* (See Ferguson (col. 4, ll. 62-67)).

RESPONSE TO ARGUMENTS

4. Applicant's arguments (Amendment filed 7/11/2004) have been considered but are unpersuasive for the following reasons

Applicant's arguments are moot based on new grounds of rejection necessitated by Applicant's amendments to the claims; also,

Applicant's response fails to seasonably challenge Official Notice evidence presented in the Prior Office Action.

It is well settled that "Applicant must seasonably challenge well known statements and statements based on personal knowledge when they are made. . . . A challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice. . . . If [A]pplicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, [A]pplicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made." (See MPEP 2144.03

Reliance on Common Knowledge in the Art or Well Known Prior Art 8 ed., August 2001, pp. 2100-129 and 2100-130).

In this instance, Applicant's Response fails to demand a reference in support of the Official Notice evidence cited by the Examiner in the prior Office action concerning the obviousness rejections of the claims which were rejected based on Official Notice. And, Applicant's response lacks adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the Official Notice and thereby fails to seasonably challenge the Official Notice rejections of the instant invention; therefore, said Official Notice evidence is deemed admitted.

CONCLUSION

4. Any response to this action should be mailed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or
(703) 746-7239 (for formal communications marked AFTER-FINAL) or
(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist
Crystal Park V
2451 Crystal Drive

Serial Number: 09/683,292
Art Unit: 3622

(Holt)

11

Arlington, Virginia.

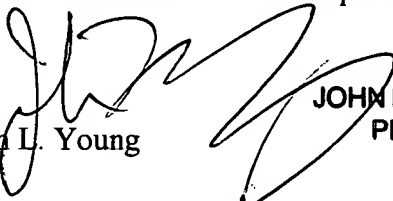
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

2451 Crystal Drive

Arlington, Virginia.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


John L. Young

Primary Patent Examiner

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

August 23, 2004